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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,981	02/20/2004	Rafail Zubok	532-7	7131
530 7590 12/10/2008 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER PELLEGRINO, BRIAN E				
ART UNIT		PAPER NUMBER		
3738				
MAIL DATE		DELIVERY MODE		
12/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/782,981

**Applicant(s)**

ZUBOK ET AL.

**Examiner**

Brian E. Pellegrino

**Art Unit**

3738

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 9, 11-16 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 9, 11-16, 20-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 4, 23, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3,5,9,11-15,20,21,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urbahns et al. (6159215) in view of Bertagnoli (5571109). Urbahns et al. disclose (Figs. 13,16) an instrument with two elongate sections **512, 618,514, 620** respectively having interior grooves the entire length along with the intervertebral engagement portion and a transverse ridge or stop **518, 624, 626** on an exterior surface. However, Urbahns et al. fail to disclose the distal ends of the elongate sections have two prongs and concave interior sides. It is noted that Urbahns et al. has extending sections (beyond the ridge) on the elongate arms of the instrument. Bertagnoli teaches (Fig. 6) a vertebral instrument with elongate ramps or guides (11,12) having interior grooves for a spinal implant **60**. Bertagnoli also teaches that the implant can have a convex or rounded profile, Fig. 8B. Bertagnoli additionally teaches that there can be two prongs (114,115) at the ends of each elongate section or guide. It would have been obvious to one of ordinary skill in the art to form the extension as prongs as taught by Bertagnoli on the ends ramps of the instrument of Urbahns et al. such that it provides more flexibility at the ends of the insertion tool by reducing the structural profile of the ramp engagement members to be prongs. Additionally, it would have been obvious to one of ordinary skill in the art to use a concave interior to match the contour of a cylindrical profile implant with protrusions to engage grooves of the inserter as

taught by Bertagnoli using the tool of Urbahns et al. such that an appropriate size is used by having separate disk pieces to form the proper length desired. With respect to claim 3, Urbahns teaches the elongate sections are releasable, col. 7, lines 30,31. Regarding claim 15, since Urbahns disclose more than two grooves, it has a middle groove that can be considered to be medially disposed and interpreted as an accommodation feature for possibly a rod.

Claims 6,16,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urbahns et al. '215 in view of Bertagnoli '109 as applied to claims 1,15 above, and further in view of Winslow (6063088). Urbahns as modified by Bertagnoli is explained above. However, Urbahns in view of Bertagnoli fail to teach the instrument includes an aperture extending along a portion of the elongate sections. Winslow teaches (Fig. 1) to include an aperture **108** in a rail on the instrument to distract intervertebral space and insert an implant. Winslow illustrates (Fig. 2) the aperture **108** is an accommodation feature for a tool **110** to stabilize the instrument during distraction as seen in Fig. 14. It would have been obvious to one of ordinary skill in the art to incorporate a rail with an aperture as taught by Winslow on the instrument of Urbahns as modified by Bertagnoli such that it ensures the instrument is stable while performing the surgical procedure on the patient.

***Allowable Subject Matter***

Claims 4,23,25,26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments filed 8/1/08 have been fully considered but they are not persuasive. Applicants argue that the prongs of Bertagnoli are not on an elongate section. However, Applicants are mistaken since an "elongate" section is a relative dimension based on comparison to something. Clearly the body of Bertagnoli's device has a length that extends in a dimension outward. Second the rejection is a combination of references and the argument focuses on the Bertagnoli device. Thus, the instrument modified is that of Urbahns et al. of which also clearly has an elongate section. The Examiner would like to emphasize that the end of the Urbahns et al. instrument clearly has an extension (beyond the ridge) of which included grooves. Therefore the modification is only to have prongs extending at the end or a reduction of the extension's lateral dimension by splitting it in half to two separate prongs in order to give spacing at the end. Since the extension of Urbahns et al. instrument already contained grooves, it would contain them even if the extension was reduced to split prongs. Thus, Applicant's argument that there would not be grooves in the prongs is mistaken since it is the combination of references and what they teach together in combination.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on M- F (7am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700  
/Brian E Pellegrino/  
Primary Examiner, Art Unit 3738